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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,708	12/04/2003	Yasuo Mori	00862.023354.	7041

5514 7590 02/20/2008  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
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2178

MAIL DATE	DELIVERY MODE
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02/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,708	<b>Applicant(s)</b> MORI ET AL.	
	<b>Examiner</b> MATTHEW J. LUDWIG	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 18, 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to the Request for Continued Examination received 11/30/2007.
2. Claims 1-12, 18, and 20-25, are currently pending in the case, with claims, 1, 7, 18, 20, and 23 being the independent claims.
3. Claims 1-12, 18, and 20-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Usami in view of Orr and further in view of Petz have been withdrawn pursuant to applicant's amendments.

### ***Claim Objections***

4. Claim 21 is objected to because of the following informalities: The limitations states 'obtained by said obtainment means *by import* to insert the new chapter into the document data'. It is unclear to the examiner what is meant by the language 'by import'. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-12, 18, 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Masuda et al., US Pat. Pub. US 2002/0087602 filed (9/10/01).**

**In reference to independent claim 1, Masuda teaches:**

***'a display controller which controls display of an object as an image indicating at least one original page contained in the document, and which controls display of a selection window upon selection of the image indicating at least one original page, wherein the selection window is displayed on a screen on which the object is displayed as the image'.*** See figures 8 through 10C illustrate a display controller for thumbnail images of document page collections are moved according to a user layout priority. Pages are selected from a plurality of electronic source documents on the collection window and moved to the composed window. See page 7, [0123 through 0125].

***'an instruction accepting unit which accepts an instruction from a user, in accordance with selection in the selection window, wherein the instruction is an instruction to divide an original chapter including pages into chapters'.*** See figure 11 which shows a detailed example in which an original electronic source document from which a thumbnail image has been moved to the composed window is indicated. The thumbnail images of 1/3 and 2/3 pages on the composed window are selected, a thumbnail image on the collection window and a thumbnail image on the collection window which correspond to the thumbnail images on the composed window, are displayed as frames or semitransparent images, thereby indicating that the thumbnail images are selected. See page 7, [0124 through 0127]. The reference mentions a collection made up of a pages which could be moved or divided into other collection windows. The claim states a 'chapter' being made up of at least one page. The examiner is broadly interpreting a collection as taught in the Masuda reference as a chapter of pages.

*'an editor which edits the document so as to generate a new chapter containing a page moved from the original chapter and to insert the new chapter into the document in accordance with the instruction accepted by said instruction accepting unit'. Figure 14 illustrates new collections with one, two, and three documents respectively. The documents found in figure 14 have re-edited and reused. See page 8, [0136 through 0139].*

*'a selection accepting unit which accepts a selection of a chapter attribute indicating chapter setting information, and employing the selected chapter attribute as a chapter attribute of the new chapter, wherein the selection accepted by the section accepting unit is a chapter attribute of the original chapter or another predetermined chapter attribute, and wherein the selection is instructed using a selection menu screen'. See page 6 and page 7, [0113 through 0133]. The reference provides an index with collection attributes which change based upon edits made to the collection. The index information provides a suggestion of chapter attributes from the original collection of documents.*

*'a setting unit which sets the chapter attribute of the new chapter in accordance with the selection accepted by said selection accepting unit'. See figure 12 which shows a detailed example of thumbnail images saved on the composed window replaced. The description is edited as indicated by the underlines found on page 7, [0127].*

**In reference to dependent claim 2, Masuda teaches:**

Figure 19 illustrates the movement of an original page to a designated position within the collection. See figure 19 and [0170 through 0171].

**In reference to dependent claim 3 and 4, Masuda teaches:**

Figure 14 illustrates collection attributes inserted into different collections which would allow for the new collection to inherit attributes from the old collection. See figure 14 and page 8, [0135 through 0139].

**In reference to dependent claim 5, Masuda teaches:**

The bookbinding portion is a portion that holds the generated electronic document made by converting the generated electronic document made by converting the generated electronic document composed of each electronic source document page obtained from the PAGEINDEX portion for managing the pages of the generated electronic document into a predetermined file format. See page 5, [0093 through 0095].

**In reference to dependent claim 6, Masuda teaches:**

See figure 11 which shows a detailed example in which an original electronic source document from which a thumbnail image has been moved to the composed window is indicated. The thumbnail images of 1/3 and 2/3 pages on the composed window are selected, a thumbnail image on the collection window and a thumbnail image on the collection window which correspond to the thumbnail images on the composed window, are displayed as frames or semitransparent images, thereby indicating that the thumbnail images are selected. See page 7, [0124 through 0127]. The reference mentions a collection made up of a pages which could be moved or divided into other collection windows. The claim states a 'chapter' being made up of at least one page. The examiner is broadly interpreting a collection as taught in the Masuda reference as a chapter of pages.

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**In reference to claims 7-12**, the claims recite similar instructions for carrying out the document processing apparatus claims numbered 1-6, respectively. Therefore, the claims are rejected under similar rationale.

**In reference to claims 18, 20-25**, the claims recite similar instructions for carrying out the document apparatus claims numbered 1-6, respectively. Therefore, the claims are rejected under similar rationale.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-12, 18 and 20-25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

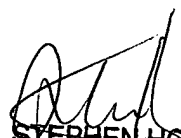
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. LUDWIG whose telephone number is (571)272-4127. The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ML

  
STEPHEN HONG  
SUPERVISORY PATENT EXAMINER